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MAR 15 2004

**DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600**

In re application of
Aaron M. Sandlers
Application No. 09/640,196
Filed: August 16, 2000
For: BUSINESS METHOD AND
PROCESSING SYSTEM

: **DECISION ON PETITION**
: **TO MAKE SPECIAL**
: **(MANUFACTURE)**
:

This is a decision on the renewed petition under 37 C.F.R §1.102(d) filed July 21, 2003 to make the above-identified application special. The renewed petition requests that the above-identified application be made special under the procedure set forth in MPEP 708.02, item I: Prospective Manufacture.

The petition is **DENIED**.

MPEP 708.02 states that a Petition to Make Special based on Prospective Manufacture must have the following: (1) the appropriate petition fee under 37 CFR 1.17(i); (2) a statement by the assignee, applicant, or attorney alleging: (A) the possession by the prospective manufacturer of sufficiently available capital (stating approximately the amount) and facilities (stating briefly the nature thereof) or that sufficiently available capital and facilities will be made available upon grant of a patent, with the proviso that if the prospective manufacturer is an individual a corroborating statement from a responsible party is required; (B) that the prospective manufacturer will not begin or increase production unless certain that the patent will be granted; (C) that the prospective manufacturer obligates themselves to manufacture the invention in the U.S. in quantity immediately upon the allowance of claims or issuance of a patent which will protect the investment of capital and facilities; and (D) that he or she has made a careful and thorough search of the prior art, or has good knowledge of the prior art, and has sent a copy of the references deemed most closely related to the subject matter encompassed by the claims.

The decision mailed May 22, 2003 answering the renewed petition filed May 2, 2003 stated that: "The renewed petition filed May 02, 2003 attempts to remedy deficiencies based on the denial of the September 30, 2002 petition under MPEP 708.02 (C) by submitting a Supplemental Declaration by Applicant in order to prove that the construction/manufacture of the system involved in the patent application involves physical components and is extremely expensive, thereby meeting the "manufacturing" requirement under item (C). Applicant's declaration states that the patent application covers a 'system' that relates to manufacturing color prints on hard machinery placed inside buildings and would require high end printing machinery costing about \$250,000 for the machinery and \$50,000 for setting up the facility. However, nowhere in the claims in the pending patent application is there language requiring manufacturing color prints on hard machinery or any language pertaining to subject matter requiring of manufacturing."

The renewed petition filed July 21, 2003 argues that the decision mailed May 22, 2003 presumes that "business method claims do not involve the construction or manufacture of anything tangible". The decision takes no such position as to business method claims in general, but rather addresses the specific facts of the instant application. Namely, the language relied upon by Mr. Sanders in support of the declaration filed with the May 2, 2003 petition is not found in the claims. The renewed petition attempts to remedy this deficiency by using a chart to extract words from the specification/claims and interpret them. First, many of the page and line numbers provided do not contain the words listed. Second, extracting words out of context and forming an "interpretation" of those words and characterizing them as "essentially manufacturing" does not show clear correspondence between specific claim language describing the invention and language used in the declaration to support petitioner's position regarding costs associated with "manufacturing color prints on hard machinery placed inside buildings".

SUMMARY: Petition to Make Special based on Prospective Manufacture is **DENIED**.

Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Should petitioner desire reconsideration, he should supplement this petition by a declaration or statement giving the information as outlined above. Petitioner should promptly submit such a renewed petition to the Commissioner of Patents and Trademarks, Washington, D.C. 20231. The envelope should indicate that the correspondence be brought to the attention of Technology Center 3600.



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RAR/mjz: 2/19/04